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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT PAPER NUMBER

2622

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,148

Applicant(s)

SIMPSON ET AL.

Examiner

Joseph R. Pokrzywa

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 7-23, filed 11/23/05, with respect to the rejection(s) of claim(s) 1-27 under 35 U.S.C. 102, as being anticipated by Kawakami (U.S. Patent Number 6,433,884), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nozawa (U.S. Patent Number 6,781,709).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 11 and 24** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11 and 24 include functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

In lines 3 and 4 of both claims 11 and 24, while defining a program, does not define a “computer-readable medium” and is thus non-statutory for that reason. A program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claims statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-27** are rejected under 35 U.S.C. 102(e) as being anticipated by Nozawa (U.S. Patent Number 6,781,709).

Regarding **claim 1**, Nozawa discloses a computer implemented method (see Figs. 1-3), comprising transmitting a print job to a printer, the printer being responsive to the print job by converting the print job into printed media and discharging the printed media into an output tray (column 8, line 25-column 9, line 65), and displaying an indicator that indicates the identity of

the output tray (see Figs. 3, 18 and 19, column 9, line 66-column 10, line 65, and column 19, lines 19-51).

Regarding **claim 2**, Nozawa discloses the method discussed above in claim 1, and further teaches that the printer includes a plurality of output trays (see Figs. 3, 18 and 19).

Regarding **claim 3**, Nozawa discloses the method discussed above in claim 2, and further teaches that the indicator further indicates the present capacity of the output tray to receive additional media (see Figs. 12, 14, and 19, column 15, line 28-column 16, line 31, and column 19, lines 19-51).

Regarding **claim 4**, Nozawa discloses the method discussed above in claim 3, and further teaches of periodically updating the indicator while the print job is being printed (see Fig. 7, column 12, lines 46-column 13, line 34).

Regarding **claim 5**, Nozawa discloses the method discussed above in claim 3, and further teaches that the indicator includes an image of the output tray with media contained therein (see Figs. 18 and 19).

Regarding **claim 6**, Nozawa discloses the method discussed above in claim 3, and further teaches that the indicator includes an image of the output tray with a stack of media contained therein (see Figs. 18 and 19) and the method further comprising, while media is being discharged into the output tray, periodically updating the image so as to increase the thickness of the stack (see Figs. 18 and 19).

Regarding **claim 7**, Nozawa discloses the method discussed above in claim 3, and further teaches that the indicator includes an animated image of the printer (see Figs. 3, 18 and 19, column 9, line 66-column 10, line 65, and column 19, lines 19-51).

Regarding **claim 8**, Nozawa discloses the method discussed above in claim 3, and further teaches that the displaying step includes the substeps of displaying an image of the output tray, and while the printed media is being discharged in the output tray, displaying an image of media moving into the output tray (see Figs. 3, 18 and 19, column 9, line 66-column 10, line 65, and column 19, lines 19-51).

Regarding **claim 9**, Nozawa discloses the method discussed above in claim 3, and further teaches that the indicator includes an image and the method further comprising periodically determining the present number of media in the output tray, and when the present number is within a first pre-determined range, causing the image to be displayed in a first configuration, and when the present number is within a second pre-determined range, causing the image to be displayed in a second configuration (see Figs.10, 12, 14, and 19, column 15, line 28-column 16, line 31, and column 19, lines 19-51).

Regarding **claim 10**, Nozawa discloses the method discussed above in claim 3, and further teaches that the indicator includes an image and the method further comprising periodically determining the present number of media in the output tray, and when the present number is within a first pre-determined range, causing the image to be displayed in a first color, and when the present number is within a second pre-determined range, causing the image to be displayed in a second color (see Figs.10, 12, 14, and 19, column 15, line 28-column 16, line 31, column 17, lines 2-11, and column 19, lines 19-51).

Regarding **claim 11**, Nozawa discloses a server (see Figs. 1-3), comprising means for receiving a request from a client (column 8, line 3-column 9, line 3), means for responding to the request by transmitting a program of computer readable instructions to the client (column 8, line

Art Unit: 2622

3-column 9, line 3), the program for enabling the client to use a specific printer having a plurality of output trays to print a document (column 8, line 25-column 9, line 65), and display an indicator that indicates the identity of an output tray from the plurality of output trays that receives the document (see Figs. 3, 18 and 19, column 9, line 66-column 10, line 65, and column 19, lines 19-51).

Regarding *claim 12*, Nozawa discloses the server discussed above in claim 11, and further teaches that the server is the printer (column 8, line 14-column 9, line 48).

Regarding *claim 13*, Nozawa discloses the server discussed above in claim 11, and further teaches that the indicator includes an image of the printer (see Figs. 3-19).

Regarding *claim 14*, Nozawa discloses the server discussed above in claim 11, and further teaches that the indicator includes an image of the output tray that is receiving the document (see Figs. 18 and 19, column 19, lines 20-51).

Regarding *claim 15*, Nozawa discloses the server discussed above in claim 11, and further teaches that the client is a personal computer connected to the server over a network (column 8, line 14-column 9, line 48).

Regarding *claim 16*, Nozawa discloses the server discussed above in claim 11, and further teaches that the indicator further indicates the present capacity of the output tray that is receiving the document to accept additional media (see Figs. 10, 12, 14, and 19, column 15, line 28-column 16, line 31, and column 19, lines 19-51).

Regarding *claim 17*, Nozawa discloses the server discussed above in claim 11, and further teaches that the indicator includes an animated image of the printer (see Fig. 19, and column 19, lines 19-51).

Regarding **claim 18**, Nozawa discloses the server discussed above in claim 11, and further teaches that the program is Web content (column 7, line 40-column 9, line 34).

Regarding **claim 19**, Nozawa discloses a computer readable medium embodying a program of instructions (column 8, line 3-column 9, line 3) for causing a computer to perform method steps, the method steps comprising displaying an indicator that identifies an output tray in a printer that is presently receiving a particular print job (see Figs. 3, 18 and 19, column 9, line 66-column 10, line 65, and column 19, lines 19-51).

Regarding **claim 20**, Nozawa discloses the computer readable medium discussed above in claim 19, and further teaches that the indicator includes an image of the printer with media dynamically moving into the output tray (see Figs. 18 and 19, and column 19, lines 19-51).

Regarding **claim 21**, Nozawa discloses the computer readable medium discussed above in claim 19, and further teaches that the program of instructions is Web content (column 7, line 40-column 9, line 34).

Regarding **claim 22**, Nozawa discloses the computer readable medium discussed above in claim 19, and further teaches that the method steps further comprising displaying an indicator that indicates the present capacity of the output tray to receive additional media (see Figs. 10, 12, 14, and 19, column 15, line 28-column 16, line 31, and column 19, lines 19-51).

Regarding **claim 23**, Nozawa discloses the computer readable medium discussed above in claim 19, and further teaches that the indicator includes an animated image of the printer (see Figs. 18 and 19, and column 19, lines 19-51).

Regarding **claim 24**, Nozawa discloses a printer having a plurality of output trays (see Fig. 3), comprising apparatus for responding to a request received from a client by transmitting a

Art Unit: 2622

program of computer readable instructions to the client (column 8, line 3-column 9, line 3), the program for enabling the client to use the printer to print a document (column 8, line 25-column 9, line 65), and display an indicator that indicates an output tray from the plurality of output trays that receives the document (see Figs. 3, 18 and 19, column 9, line 66-column 10, line 65, and column 19, lines 19-51).

Regarding **claim 25**, Nozawa discloses the printer discussed above in claim 24, and further teaches that the indicator includes an image of the printer (see Figs. 10, 12, 14, and 19, column 15, line 28-column 16, line 31, and column 19, lines 19-51).

Regarding **claim 26**, Nozawa discloses the printer discussed above in claim 24, and further teaches that the program is further for enabling the client to inform a user the present capacity of the output tray receiving the document (see Figs. 10, 12, 14, and 19, column 15, line 28-column 16, line 31, and column 19, lines 19-51).

Regarding **claim 27**, Nozawa discloses the printer discussed above in claim 24, and further teaches that the indicator includes an animated image of the printer (see Figs. 18 and 19, and column 19, lines 19-51).

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Nakahira *et al.* (U.S. Patent Number 6,546,313) discloses a system that displays an image of output trays for a printer.

Art Unit: 2622

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrj